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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,024	09/18/2003	Reid Hayhow	10030557-1	7952
7590	07/13/2006		EXAMINER	
AGILENT TECHNOLOGIES, INC. Legal Department, DL429 Intellectual Property Administration P.O. Box 7599 Loveland, CO 80537-0599			CHUNG, PHUNG M	
			ART UNIT	PAPER NUMBER
			2138	
			DATE MAILED: 07/13/2006	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/666,024	HAYHOW, REID
	<b>Examiner</b>	<b>Art Unit</b>
	Phung My Chung	2138

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. ____ .   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/6/06</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: ____ .                                   |

***Claim Rejections - 35 USC § 112***

1. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1, lines 2-4, "reading a test file including a plurality of test vectors...; and determining a required memory needed to execute the plurality of test vectors" is not clear how it determines a required memory needed to execute the test vectors, and it is also unclear how to execute the test vectors while the plurality of test vectors are reading out from the test file? Appropriate correction is required.

As per claims 2-9, these claims are also rejected because they dependent upon the rejected base claim.

As per claim 10, lines 2-3, "logic to read a test file including a plurality of test vectors and to determine a required memory needed to execute the plurality of test vectors" is not clear how the logic determine a required memory needed to execute the plurality of test vectors and it is also unclear how the logic execute the plurality of test vectors while the plurality of test vectors are reading out from the test file? Appropriate correction is required.

As per claims 11-16, these claims are also rejected because they dependent upon the rejected base claim.

***Double Patenting***

2. Claims 1-6 and 10-13 are remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 37, 13 and 17 of copending application No. 10/681,068. (See the office action dated on 1/24/06).

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Regelman et al (6,574,626).

As per claim 1, Regelman et al disclose a method comprising:

Reading a test file including a plurality of test vectors to be applied to a device;  
and

Determining a required memory needed to execute the plurality of test vectors.

(See col. 2, lines 21-35).

As per claim 2, Jordan et al further disclose wherein determining a required memory comprises determining a required memory needed for each of a plurality of boards (Test Stations) of a tester to execute the test vectors for the board.

As per claim 3, Regelman et al further disclose wherein determining a required memory comprises determining a required memory needed for each of a plurality of pins (test points or test channels) of a tester to execute the test vectors for the pin (col. 4, lines 5-20).

As per claim 4, Regelman et al further disclose determining a required memory comprises counting the number of test vectors for each test in the test file (col. 2, lines 21-35).

As per claims 5-6 and 8-9, Regelman et al further disclose determining a first memory requirement needed for a first pin of a tester to execute the test vectors for a first test in the test file;

Setting the required memory equal the first memory requirement; and for each additional pin of tester,

Determining a second memory requirement needed for the additional pin to execute the test vectors for the first test; and

If the second memory requirement is greater than the first memory requirement, setting the required memory equal to the second memory requirement (col. 19, lines 45-60 and col. 20, lines 1-27).

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As per claim 7, Regelman et al further disclose if the required memory exceed an existing memory allotment, increasing the allotment of memory (col. 2, lines 21-35).

As per claim 10, this claim is rejected under similar rationale as set forth in claim 1.

As per claim 11, this claim is rejected under similar rationale as set forth in claim 2.

As per claim 12, this claim is rejected under similar rationale as set forth in claim 3.

As per claim 13, this claim is rejected under similar rationale as set forth in claim 4.

As per claims 14-15, these claims are rejected under similar rationale as set forth in claim 8-9.

As per claim 16, Regelman et al further disclose using the required memory to bill a customer (col. 2, lines 30-35 and col. 7, lines 14-17).

5. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phung My Chung whose telephone number is 571-272-3818. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on 571-272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Phung My Chung  
Primary Patent Examiner  
Art Unit 2138